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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/738,659 10/30/96 MOTOYAMA

T 5244-051-2X-
EXAMINER

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ART UNIT III PAPER NUMBER

32

DATE MAILED 2152

01/11/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/18/2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10, 12-19, 36, 38-44, 52-61 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10, 12-19, 36, 38-44, 52-61 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES --

* U.S. GPO: 1996-409-290/40029

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1. Claims 10, 12-19, 36, 38-44, and 52-61 are presented for examination.
2. The following is a quotation of 35 U.S.C. § 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 10, 12-19, 36, 38-44, and 52-61 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.
4. **Kraslavsky** and **Cohn** were cited as prior art in the last office action.
5. As to claim 10, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined

using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's monitored and monitoring devices because it would allow the message to be transferred globally between any devices.

6. As to claims 12-13, Kraslavsky teaches transmitting the information to the monitored device which is a business office device such as copier, facsimile machine, or printer (Abstract, and col. 2 lines 35-62).

7. As to claim 14, Kraslavsky and Cohn teach receiving the transmitted information by the monitored device; and transmitting, through Internet electronic mail, an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device (Kraslavsky, col. 2 lines 35-62; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

8. As to claim 15, Kraslavsky teaches transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device (col. 34 lines 63-67).

9. As to claim 16, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a machine and a monitoring device, comprising the steps of:

determining status information using at least one of a mechanical and electrical sensor (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently

teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and transmitting the status information from the machine to the monitoring device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device.

10. As to claim 17, Kraslavsky and Cohn teach analyzing the status information by the machine, wherein the status information is transmitted as the Internet electronic mail message from the machine when the status information is analyzed and determined to be

within a standard operating range (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

11. As to claim 18, Kraslavsky and Cohn teach determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical and electrical sensor; and transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters (Kraslavsky, col. 39 lines 20-54; Cohn, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11).

12. As to claims 52-53, Cohn inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

13. As to claim 54, Kraslavsky and Cohn teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall

in Kraslavsky and Cohn's network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

14. Claims 19, 36, 38-44, and 55-61 have similar limitations as claims 10, 12-18 and 52-54; therefore, they are rejected under the same rationale.

15. In the remarks, applicant argued in substance that

(A) Prior art does not teach transmitting a message which is an Internet electronic mail message from a monitoring device to a monitored device.

As to point (A), Kraslavsky teaches transmitting the message from a monitoring device to a monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission facilities, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet

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electronic mail message format to transmit Kraslavsky's message between the monitored device and the monitoring device because it would allow the message to be transferred globally between any devices.

(B) Applicant argues that one of ordinary skill in the art would not modify the primary reference of Kraslavsky to operate using Internet electronic mail as disclosed in the secondary reference of Cohn, and applicant provides various rationales to show Kraslavsky and Cohn might not be combined together.

As to point (B), Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, Kraslavsky inherently teaches the information of the printer is obtained from sensors as clearly described by Banno et al patent no. 4,876,606 dated 10/24/89 col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to communicate (transmit and receive) between Kraslavsky's monitored and monitoring devices because it would allow the message to be transferred globally between any devices.

The test for obviousness is not whether the features of one reference may be bodily incorporated into the other reference to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art.

"(T)he proper inquiry should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest one skilled in the art the modification called for by the claims", In re Bascom, 109 USPQ 98, 100 (CCPA 1956). "What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." In re Sneed, 218 USPQ 385, 389 (CAFC 1983). "The argument that one cannot bodily incorporate the two set of references because in one the speed of the air-fuel mixture is allegedly subsonic, whereas in the other it is sonic, is irrelevant. The test for obviousness is not whether the

features of one reference may be bodily incorporated into another reference. Rather, we look to see whether the combined teachings render the claimed subject matter obvious", *In re Wood and Eversole*, 202 USPQ, 171, 174 (CCPA, 1979).

Furthermore, In response to applicant's argument that one of ordinary skill in the art would not modify the primary reference of Kraslavsky to operate using Internet electronic mail as disclosed in the secondary reference of Cohn, and applicant provides various rationales to show Kraslavsky and Cohn might not be combined together. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(C) Applicant argues that the Official Action has shown no motivation to combine the teachings of Kraslavsky and Cohn.

As to point (C), In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill

in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kraslavsky teaches using message to communicate status and control information, font information, layout information, quality and common environment information, and configuration information between a monitored device (printer 4, figure 1) and a monitoring device (NTWK ADMIN PC 14, figure 1, col. 9 lines 35-50, col. 14 lines 28-48). Moreover, message is being delivered using Internet electronic mail is well known at the time of the invention, and Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission facilities, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36). Examiner has provided the motivation that it would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message format to deliver Kraslavsky's message between the monitored device and the monitoring device because it would allow the message to be transferred globally between any devices.

16. Limitations that are argued by applicant but are not in claimed language are not being considered by Examiner.

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17. Applicant's arguments filed on 10/18/2000 have been fully considered but they are not deemed to be persuasive.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached at (703) 305-4815.

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Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

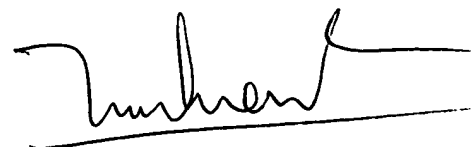
or faxed to:

(703) 308-9051, (for formal communications; please mark
"EXPEDITED PROCEDURE")

Or:

(703) 305-7201 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).



LE HIEN LUU
PRIMARY EXAMINER

December 21, 2000